



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MF

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/646,183 09/14/00 BREINER

U 48876

EXAMINER

IM22/1106

KEIL & WEINKAUF
1101 CONNECTICUT AVENUE NW
WASHINGTON DC 20036

HOLKE, V

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|---|--------------------------------------|--------------------------------------|
| Office Action Summary | Application No. 09/646,183 | Applicant(s) BREINER ET AL |
| | Examiner VERONICA HOKE | Art Unit 1714 |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | |
| Period for Reply | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | |
| - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. | | |
| - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. | | |
| - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. | | |
| - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). | | |
| - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | |
| Status | | |
| 1) <input type="checkbox"/> Responsive to communication(s) filed on _____. | | |
| 2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final. | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213. | | |
| Disposition of Claims | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-13</u> is/are pending in the application. | | |
| 4a) Of the above, claim(s) _____ is/are withdrawn from consideration. | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1-13</u> is/are rejected. | | |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. | | |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement. | | |
| Application Papers | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner. | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved. | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | |
| Priority under 35 U.S.C. § 119 | | |
| 13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). | | |
| a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: | | |
| 1. <input type="checkbox"/> Certified copies of the priority documents have been received. | | |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. | | |
| 3. <input checked="" type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). | | |
| *See the attached detailed Office action for a list of the certified copies not received. | | |
| 14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). | | |
| Attachment(s) | | |
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | | |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>4</u> | | |
| 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ | | |
| 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | | |
| 20) <input type="checkbox"/> Other: _____ | | |

Art Unit: 1714

The preliminary amendment of September 14, 2000 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9-13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kimura et al.

Bis [(hindered piperidine) N,N di (alkoxypropionoyl)]alkylene diamines are disclosed as being reactive HALS preservatives for polyamide which may be introduced during the polymer's

Art Unit: 1714

polycondensation- col.18, line 32 to the last line and col.10, lines 5-10. The simultaneous incorporation of a pigment is optional (col.9, lines 52-64).

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rody et al.

Rody et al discloses a HALS- stabilized polyamide wherein the HALS compound is built into the polyamide's backbone by its presence as a co-reactant during the polymer's condensation type polymerization. See col.1 - col.5, line 3 and col.11 , line 56 et seq. particularly the HALS species ,N,N' - (2,2,6,6, tetramethylpiperidine 4-yl) hexamethylene diamine, bridging cols. 12 and 13 as the diamine reactant with amide forming compounds. The polyamide may have an average molecular weight of 4,500 according to example 13 in col.13. Such solid amide resinous materials are presumed to be capable of being extruded into sheets or being capable of being molded into shaped articles.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over German published application no. 3233953.

Applicants chemically incorporate this reference's common HALS preservative for polyamides (last formula on page numbered one) by similarly introducing it prior to or during the polymer's

Art Unit: 1714

polymerization process. Common amide forming coreactants comprise lactams (page 5 , line 6.). Being reacted in similar relative molar / weight proportions, (reference in the last paragraph on page 4), applicants products are considered to inherently manifest the same type properties.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 12 provides for the use of compounds to preserve polyamides , but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10 and 12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Art Unit: 1714



VERONICA P. HOKE
PRIMARY EXAMINER

vph

October 26, 2001

703 308-2444